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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/827,498

04/19/2004

Liangjing Chen

AMBI1001

3464

34725

7590

03/08/2007

CHALKER FLORES, LLP

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EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

03/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/827,498

Applicant(s)

CHEN ET AL.

Examiner

Richard G. Hutson

Art Unit

1652

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-128 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

Claims 1-128 are pending and at issue for examination.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, 46-58, 59, 60, 84-96, 97, 98, 102-112, 115-125, 127 and 128, drawn to an isolated hyperactive reverse transcriptase, classified in class 435, subclass 194.
- II. Claims 29-35, 36-45, drawn to an isolated reverse transcriptase having substantially reduced RNase H activity, classified in class 435, subclass 194.
- III. Claims 61-83, drawn to an isolated nucleic acid encoding a hyperactive reverse transcriptase, classified in class 435, subclass 194.
- IV. Claims 99-101, drawn to a method for RNA amplification, classified in class 435, subclass 91.21.
- V. Claims 113, 114, 126, drawn to an aRNA, classified in class 536, subclass 23.1.

For each of inventions I-V above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-IV and one of the inventions corresponding to a reverse transcriptase selected from the

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group consisting of AMV, M-MLV, HTLV-1, BLV, RSV, HFV, R2 Bombyx mori and HIV reverse transcriptase.

For each of inventions I-V above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-IV and one of the inventions corresponding to a single mutation selected from the group consisting of H638, Y586, D653, D524 and E562.

For each of inventions I-IV above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-IV and one of the inventions corresponding to a single mutation selected from the group consisting of D153, A154, F155, F156, C157 and L158.

The inventions are distinct, each from the other because of the following reasons:

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Inventions corresponding to the reverse transcriptases selected from the group consisting of AMV, M-MLV, HTLV-1, BLV, RSV, HFV, R2 *Bombyx mori* and HIV reverse transcriptase are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to different structurally different reverse transcriptase polypeptides that comprise different amino acid sequences and correspondingly different functions.

Inventions corresponding to the mutations selected from the group consisting of H638, Y586, D653, D524 and E562 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to structurally different reverse transcriptase mutations that comprise different amino acid sequences and correspondingly different functions.

Inventions corresponding to the mutations selected from the group consisting of D153, A154, F155, F156, C157 and L158 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to structurally different reverse transcriptase mutations that comprise different amino acid sequences and correspondingly different functions.

Inventions I-III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to divergent molecules having different functions and effects. The polynucleotides of groups III and V are directed to structurally and functionally different molecules having different nucleotide sequences. The polypeptides of groups I and II are directed to structurally and functionally different molecules having different amino acid sequences.

Inventions I and II and inventions IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides can be used in a materially different process such as one in which the polypeptide is used to generate an antibody.

The polynucleotides of group III and V are unrelated to the methods of group IV as they are neither used nor made by the method of groups IV.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Richard G. Hutson', followed by a long horizontal line extending to the right.

Richard G Hutson, Ph.D.  
Primary Examiner  
Art Unit 1652

rg  
3/5/2007